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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/690,409
		Filing Date	October 17, 2000
		First Named Inventor	Hans-Peter Wild
		Group Art Unit	3721
		Examiner Name	Thanh K. Truong
Total Number of Pages in This Submission	1	Attorney Docket Number	30051/32006

ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name	MARSHALL, GERSTEIN & BORUN LLP Bryan J. Lempia - 39,746
Signature	
Date	November 3, 2003

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(Bryan J. Lempia)



Attorney Docket No.: 30051/32006
(PATENT)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hans-Peter Wild

Application No.: 09/690,409

Group Art Unit: 3721

Filed: October 17, 2000

Examiner: Thanh K. Truong

For: Apparatus for Applying Drinking Straws

APPELLANTS' BRIEF -- RESUBMITTED

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Dear Sir:

This brief is being resubmitted in response to a communication/action from the United States Patent & Trademark Office dated October 3, 2003. The Summary of Invention (Section I below) has been revised to include specific reference to both the written description by page and line numbers, and to the drawings by reference number.

This brief is resubmitted in furtherance of the Notice of Appeal, filed in this case on June 23, 2003, and *received* by the United States Patent & Trademark Office on June 26, 2003. Thus, this Appellants' Brief was originally timely filed on Tuesday, August 26, 2003, within two months from the date of the appeal.

The fees required under §1.17(f) were timely paid with the originally filed version of this brief. No extension of time fee is believed due to accompany this Appellants' Brief. Thus, no fees accompany this resubmission of the brief.

This brief is retransmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. §1.192 and M.P.E.P. §1206:

- I. Real Party In Interest
- II. Status of Claims
- III. Status of Amendments
- IV. Summary of Invention
- V. Issues
- VI. Grouping of Claims
- VII. Arguments
- VIII. Claims Involved in the Appeal

Appendix A Claims

I. REAL PARTY IN INTEREST

The present application has been assigned to Indag Gesellschaft FUR of Heidelberg, Federal Republic of Germany. Evidence of the assignment was recorded on February 28, 2001, at Reel 011569, Frame 0709.

II. STATUS OF CLAIMS

Claims 1-6 have been finally rejected in an official action dated April 23, 2003. Claims 1-6 have been rejected under 35 U.S.C. §102(b) as anticipated by Geyssel, U.S. Patent No. 4,584,046 (Geyssel).

III. STATUS OF AMENDMENTS

A preliminary amendment was submitted with the application on October 17, 2000. The preliminary amendment has been entered and considered.

An amendment was submitted on April 29, 2002 in response to a first non-final official action mailed January 29, 2002. That amendment was entered and considered.

An amendment was submitted on September 10, 2002 in response to a first *final* official action mailed July 11, 2002. That amendment was not entered and considered.

A Request for Continued Examination (RCE) was submitted on October 11, 2002, and included an amendment (similar, but not identical, to the unentered amendment of September 10, 2002) in response to the final action mailed on July 11, 2002. A Supplemental Amendment was submitted on November 4, 2002, supplementing the RCE submission. These amendments were entered and considered.

An amendment was submitted on February 20, 2003 in response to a non-final official action mailed November 22, 2002. That amendment was entered and considered.

A second *final* official action was mailed on April 23, 2003, from which this appeal is taken. No amendments have been filed in response to the second final action.

All amendments submitted to date have been entered, and no amendments remain outstanding or unentered. Further, no amendments accompany this Appellants' Brief.

IV. SUMMARY OF INVENTION

The present application is directed to an apparatus for applying drinking straws to stand up beverage bags. The invention is set forth in claim 1 as an apparatus (1; see FIG. 1, and page 3, lines 1-5) for applying a drinking straw (2 - see FIG. 2, and page 3, lines 1-5) to a receiving surface (3a - see FIG. 2, and page 3, lines 1-5) of a stand up bag (3 - see FIG. 2, and page 3, lines 1-5). The stand up bag (3) is supplied on a conveying surface (4a - see FIG. 2, and page 3, lines 20-24) to a transfer means (5 - see FIG. 1, and page 3, lines 6-8) for drinking straws(2). The stand up bag (3) lies with a side surface (not numbered - but see FIG. 2, and page 3, lines 24-25) resting on the conveyor surface (4a - see FIG. 2, and page 3, lines 24-25). The side surface on which the bag lies (page 3, lines 24-25) is generally opposite the receiving surface (3a). The transfer means (5) is arranged such that the drinking straw (2), while being handed over (see FIGS. 1 and 2, and page 4, lines 3-17), encloses an acute angle (α - see FIGS. 1 and 2, and page 3, lines 20-24) with the conveying surface (4a).

Claim 5 defines the invention as an apparatus (1) for applying drinking straws (2) to receiving surfaces (3a) of stand up bags (3). The apparatus (1) is comprised of stand up bags (3) having a bottom surface (not numbered - but see FIGS. 1 and 2 as side shown in phantom in FIG. 2 and *neither* resting on conveyor surface (4a) nor receiving a straw), a top end (not numbered - but see FIGS. 1 and 2, pinched end opposite bottom surface), and at least two opposite side surfaces (side 3a and opposite side resting on conveyor surface 4a) interconnecting the bottom surface and the top end. The apparatus also comprises a supply of drinking straws (9 and 9a - see page 4, lines 5-6) and a conveyor surface (4a) for conveying the stand up bags (3). The apparatus (1) further comprises a transfer means (5) constructed and arranged for transferring (see FIGS. 1 and 2, and page 4, lines 3-12) the drinking straws (2) onto the stand up bags (3). Each of the stand up bags (3) is conveyed having one of the opposite side surfaces (see FIGS. 1 and 2, and page 3, lines 20-24) resting on the conveyor surface (4a). A drinking straw (2) is applied (see FIG. 2, and page 4, lines 13-17) to the other of the opposite side surfaces (3a) of each of the stand up bags (3).

Claim 6 defines the invention as an apparatus (1) for applying drinking straws (2) to receiving surfaces (3a) of stand up bags (3). The apparatus (1) is comprised of stand up bags (3) having a bottom surface (see FIGS. 1 and 2, bottom surface shown in phantom in FIG. 2), a top end formed by a sealing line closing a filling opening (see FIGS. 1 and 2), and at least two opposite non-planar side surfaces (see FIG. 2, and page 3, line 26 -page 4, line 2, and page 1, lines 18-22) interconnecting the bottom surface and the top end and forming an angle of less than 45° (see FIG. 1, and page 4, lines 18-23, and page 3, line 20 - page 4, line 2). The apparatus (1) also comprises a supply (9, 9a) of drinking straws (2) and a conveyor surface (4a) for conveying the stand up bags (3). The apparatus (1) further comprises a transfer means (5) constructed and arranged for transferring (see FIGS. 1 and 2, and page 4, lines 3-12) the drinking straws (2) onto the stand up bags (3). Each of the stand up bags (3) is conveyed having one of the opposite non-planar side surfaces (side opposite 3a) resting on the conveyor surface (4a). A drinking straw (2) is applied (see FIG. 2, and page 4, lines 13-17) to the other (3a) of the opposite non-planar side surfaces of each of the stand up bags (3).

V. ISSUES

- A. Whether Geyssel discloses all of the limitations of claims 1-4?
- B. Whether Geyssel discloses all the limitations of claim 5?
- C. Whether Geyssel discloses all of the limitations of claim 6?

VI. GROUPING OF CLAIMS

For the purpose of this Appellants' Brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

- A. Claims 1-4 will stand or fall together.
- B. Claim 5 will stand or fall alone.
- C. Claim 6 will stand or fall alone.

In Section VII, the appellants include arguments supporting the separate patentability of each claim group as required by M.P.E.P. §1206.

VII. ARGUMENTS

It is well-known that a single prior art reference must teach all of the rejected claim limitations. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ If this requirement is not met, anticipation has not been established. The appellants believe that the cited anticipatory reference, Geyssel, does not teach all of the rejected claim limitations, for the reasons set forth below.²

A. Geyssel Does Not Anticipate Claims 1-4

Independent claim 1 recites that "the stand up bag lies on a side surface resting on the conveyor surface that is generally opposite said receiving surface." The conveyor surface is that which moves the stand up bag through the apparatus. The receiving surface is that surface upon which the drinking straw is placed. The surface on which the bag lies is the surface *opposite* the straw receiving surface. Geyssel fails to disclose or suggest at least this limitation of independent claim 1. Claim 1 also recites that "the drinking straw (2) while being handed over encloses an acute angle (α) with the conveying surface (4a)." Geyssel fails to disclose or suggest this limitation of claim 1, when considered in light of the other recited surfaces.

The examiner continues to point to figure 9 in Geyssel as allegedly disclosing all of the limitations of rejected claim 1. In the final action, paragraph 4, the examiner states that "[i]n respond (*sic.*) to the applicant's argument that the article which is adapted to receive the drinking straw, in figure 9 of Geyssel, is resting on the conveyor surface on its bottom surface and not on the side surface, the examiner's interpretation of the figure 9 Geyssel (*sic.*) is that the package 12 is resting on its side as claimed." This comment alone does not address the fact that claim 1 recites the drinking straw, regardless of which side the stand up bag is resting on, *as being applied to the side of the bag facing opposite the side resting on the conveyor surface.*

The examiner further states that Geyssel discloses that the straw transfer device can be tilted relative to two perpendicular axes in order that the drinking straws can be secured in different directions and on variously inclined surfaces of a package. The examiner points to the abstract and column 2, lines 24-31 of Geyssel in support. This comment and its supporting

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² Though not discussed herein, an obviousness rejection requires that the prior art reference or combination of references teach or suggest all of the claim limitations. In the final action, no obviousness rejection has been raised based on Geyssel. However, the appellants believe that Geyssel does not render obvious claims 1-6. Geyssel does not suggest modifying its disclosed apparatus to achieve those defined in claims 1-6.

excerpts do not set any specific boundary limits for the amount of tilt and/or incline that can be accommodated, nor any reasons for having such limits. More importantly, the comment and supporting excerpts do not specify any particular relationship between the straw receiving surface and the surface resting on the conveyor. Claim 1 requires a specific relationship that is simply not disclosed or suggested in Geyssel.

However, in order to overcome this fatal shortcoming, the examiner then extrapolates the broad and highly general statements in Geyssel in stating that "the package 12 from figure 9 can be replaced by any articles that the side surface is resting on the conveyor surface opposite to the receiving surface...." This extrapolation erroneously goes well beyond the teachings of Geyssel. The reference admittedly discloses that a variety of different articles could be conveyed and receive a straw utilizing the Geyssel apparatus. However, Geyssel does not even suggest or infer altering the only disclosed arrangement for the straw receiving surface and the surface resting on the conveyor. Geyssel discloses only that the articles rest on one horizontally oriented surface and that the straws are applied only to a somewhat vertically oriented surface directly adjacent to the surface resting on the conveyor. The straw receiving surface in Geyssel is never disclosed or suggested to be a surface *opposite the surface on which the articles rest.*

It is well known that a prior art reference must show the identical structure to that claimed in as complete detail as the invention.³ Further, the elements in the reference must be arranged as required by the claim.⁴ Geyssel does not disclose the identical structure in as complete detail as claimed, nor does it disclose the same claimed arrangement.

Geyssel admittedly teaches that the straw transfer means can be tilted at a side to side angle relative to the receiving surface so that a straw can be applied at an angle when viewed facing that receiving surface. Geyssel also admittedly teaches that the transfer means can be tilted forward to accommodate a receiving surface of the article that is inclined relative to vertical. However, to then say that Geyssel also discloses applying a drinking straw to a side of an article that is opposite the side of the article lying on the conveyor surface, regardless of the definition of that side, is erroneous. Geyssel teaches nothing of the kind.

When reviewing the language of the abstract, the excerpt at column 2, lines 24-31, and figure 9, as well as the entire disclosure, it is readily apparent that Geyssel only discloses or suggests articles resting on one surface and applying a drinking straw to an upstanding surface

³ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁴ *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

that is directly adjacent to that surface on which it rests. Geyssel fails to disclose the apparatus of claim 1 in as complete detail as claimed. Gyessel also fails to disclose the specific arrangement of the stand up bag surfaces and the conveyor surface exactly as claimed. For at least this reason, Geyssel does not anticipate claim 1.

Geyssel may disclose that a drinking straw, while being handed over to an article, can enclose an acute angle relative to the conveying surface. However, Geyssel does not disclose such an arrangement in combination with the specific bag surface arrangement recited in claim 1 and discussed immediately above.

Geyssel simply does not disclose all of the limitations of claim 1. As a result, Geyssel does not anticipate claim 1 or corresponding dependent claims 2-4. The rejection of claim 1 and corresponding dependent claims 2-4 must be withdrawn. Claims 1-4 are allowable in view of the art of record.

B. Geyssel Does Not Anticipate Claim 5

Claim 5 recites a stand up bag with a bottom surface, a top end, and a pair of side surfaces interconnecting the top end and bottom surface. Substantially similar to the claim 1 limitation discussed above, claim 5 also recites that "each of the stand up bags is conveyed having one of the opposite side surfaces resting on the conveyor surface, and wherein a drinking straw is applied to the other of the opposite side surfaces of each of the stand up bags." Again, Geyssel does not teach or suggest this limitation of claim 5.

Claim 5 specifically requires that the stand up bag have a bottom surface, but rest on one of its opposed side surfaces. Claim 5 also specifically requires that the drinking straw be applied to the other of the opposed side surfaces. As discussed above, Geyssel only discloses or suggests applying a drinking straw to a receiving surface of an article, wherein the receiving surface is directly adjacent to the surface resting on a conveyor which conveys the article. Geyssel does not disclose the arrangement of claim 5.

Claim 5 is not anticipated by the Geyssel disclosure. Geyssel fails to disclose all of the recited claim limitations in as complete detail and in the same arrangement as claimed. This rejection must be withdrawn. Claim 5 is allowable in view of the art of record.

C. Geyssel Does Not Anticipate Claim 6

Claim 6 recites a stand up bag having a bottom surface, a top end, and a pair of opposed non-planar side surfaces. The side surfaces are curved or "cushion" shaped. Similar to claims 1 and 5 above, claim 6 also recites that "each of the stand up bags is conveyed having one of the opposite non-planar side surfaces resting on the conveyor surface, and wherein a drinking straw is applied to the other of the opposite non-planar side surfaces of each of the stand up bags." As with claims 1 and 5 above, Geyssel does not disclose applying a drinking straw to a receiving surface of an article that is opposite the surface lying on a conveyor. For at least this reason, Geyssel fails to anticipate claim 6.

Claim 6 also recites that both the side resting on the conveyor and the straw receiving surface are *non-planar* surfaces. Geyssel also fails to disclose or suggest these limitations of claim 6. At column 1, lines 43-48, Geyssel discloses that the apparatus can be utilized to apply drinking straws to objects such as packages, *bottles*, bags, etc., which move past on a conveyor. Clearly, at least bottles and bags may have non-planar surfaces. However, when viewed as a whole, Geyssel fails to teach or suggest resting any disclosed article on one of its non-planar side surfaces while applying a drinking straw to the opposite non-planar side surface. Each of the figures and the entire description of Geyssel teach only that the article or articles stand up on one surface which is flat or planar, and that a drinking straw is applied to a surface directly adjacent that planar surface resting on the conveyor. Geyssel does not teach any further. For at least this reason, Geyssel fails to anticipate claim 6.

Claim 6 is not anticipated by the Geyssel disclosure. Geyssel fails to disclose all of the recited claim limitations in as complete detail and in the same arrangement as claimed. This rejection must be withdrawn. Claim 6 is allowable in view of the art of record.

In view of the foregoing arguments, claims 1-6 are in condition for allowance as presently written.

VIII. CLAIMS INVOLVED IN THE APPEAL

A copy of claims 1-6 involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include all of the previous amendments filed by the appellants and entered by the examiner to date in this application.

Dated: November 3, 2003

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/690,409

1. In an apparatus for applying a drinking straw to a receiving surface of a stand up bag which is supplied on a conveying surface to a transfer means for drinking straws, the improvement comprising that the stand up bag lies with a side surface resting on the conveyor surface that is generally opposite said receiving surface (3a) and that said transfer means (5) is arranged such that the drinking straw (2) while being handed over encloses an acute angle (α) with the conveying surface (4a).

2. The apparatus according to claim 1, wherein said angle (α) corresponds to the inclination of said receiving surface (3a) on the stand up bag (3) relative to said conveying surface (4a).

3. The apparatus according to claim 1 or 2, wherein the stand up bag (3) lies on the conveying surface (4a) with an outer surface opposite to said receiving surface (3a) and said angle (α) corresponds to the angle of enclosure which is enclosed by said receiving surface (3a) of the stand up bag (3) with the opposite outer surface of the stand up bag (3).

4. The apparatus according to claim 1, wherein said transfer means comprises a transfer drum (6) which is rotatable about a central axis (6a) which is inclined by said angle (α) and on the periphery of which the drinking straws (2) can be supplied.

5. An apparatus for applying drinking straws to receiving surfaces of stand up bags, the apparatus comprising:

stand up bags having a bottom surface, a top end, and at least two opposite side surfaces interconnecting the bottom surface and the top end;

a supply of drinking straws;

a conveyor surface for conveying the stand up bags; and
a transfer means constructed and arranged for transferring the drinking straws onto the stand up bags,

wherein each of the stand up bags is conveyed having one of the opposite side surfaces resting on the conveyor surface, and wherein a drinking straw is applied to the other of the opposite side surfaces of each of the stand up bags.

6. An apparatus for applying drinking straws to receiving surfaces of stand up bags, the apparatus comprising:

stand up bags having a bottom surface, a top end formed by a sealing line closing a filling opening, and at least two opposite non-planar side surfaces interconnecting the bottom surface and the top end and forming an angle of less than 45°;

a supply of drinking straws;

a conveyor surface for conveying the stand up bags; and

a transfer means constructed and arranged for transferring the drinking straws onto the stand up bags,

wherein each of the stand up bags is conveyed having one of the opposite non-planar side surfaces resting on the conveyor surface, and wherein a drinking straw is applied to the other of the opposite non-planar side surfaces of each of the stand up bags.